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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,908	11/07/2000	Osamu Niwa	A33711 PCT U	5718

21003 7590 06/02/2003

BAKER & BOTTS
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NEW YORK, NY 10112

EXAMINER

HON, SOW FUN

ART UNIT	PAPER NUMBER
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1772

10

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS to

Office Action Summary

Application No.

09/674,908

Applicant(s)

NIWA ET AL.

Examiner

Sow-Fun Hon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/26/03 has been entered.

Withdrawn Rejections

2. The 35 U.S.C. 103(a) rejections have been withdrawn due to the amendment in Paper # 8 (filed 03/26/03) and the new rejections below.

New Rejections

Claim Rejections - 35 USC § 112

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear whether the metal deposited layer is a vapor deposited layer.

Claim Rejections - 35 USC § 102

5. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Horii.

Horii teaches a balloon formed from heat sealing a plastic film (transparent) with a metal vapor deposited layer formed on one side (column 1, lines 15-45). The transparent plastic film is based on polyamides and polyolefins, and a seal layer (column 2, lines 55-60).

Claim Rejections - 35 USC § 103

6. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being obvious over Gasse et al.

Gasse et al. teaches a film composed of a polyamide resin layer (A), a polyamide resin layer blend (B) of 10-60 weight % of amorphous polyamide resin and 40-90 weight % of aliphatic polyamide resin, an adhesive layer(D) (bonding layer) and a seal layer (C) (heat sealing layer) (abstract). A preferred five-layer structure is A/D/B/D/C, wherein D is a polyolefin layer (bonding layer of polyethylene or polypropylene). Total film thickness is 15 to 400 μm (column 2, lines 10-55). The film is shaped into a balloon (film bubble) (column 3, lines 15-20).

The recitation “for forming a vapor deposited balloon” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Gasse et al. teaches that prior art film prepared from polyamide blends are biaxially stretched on grounds of strength, but can then no longer be thermoformed (column 1, lines 10-40). However, when thermoforming is not used, strength from biaxial stretching does not have to be sacrificed. Since Gasse teaches that film strength is obtained from biaxial stretching, it would have been obvious to one of ordinary skill in the art to have biaxially stretched the film in the absence of the need to use thermoforming to further process the film.

Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant case, it does not matter what machines are being used to produce the presently claimed biaxially oriented film.

7. Claims 3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Last in view of Gasse et al.

Last has balloons (column 9, lines 10-25) made from transparent (high clarity) polyolefin (polyene) film laminates which are stretched in biaxial directions having a thickness of 0.35 μm (0.00025 in.) to 254 μm (0.01 in.) (column 8, lines 1-30). Last teaches that biaxially oriented film has greater strength and orientation in the longitudinal direction for use in balloons. Lamination with metal foil gives metallic effects (column 9, lines 5-35). Last, however, fails to teach the specific claimed five-layer composition with the two polyamide layers.

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Gasse et al. teaches a film composed of a polyamide resin layer (A), a polyamide resin layer blend (B) of 10-60 weight % of amorphous polyamide resin and 40-90 weight % of aliphatic polyamide resin, an adhesive layer(D) (bonding layer) and a seal layer (C) (heat sealing layer) (abstract). A preferred five-layer structure is A/D/B/D/C, wherein D is a polyolefin layer (bonding layer of polyethylene or polypropylene). Total film thickness is 15 to 400 μm (column 2, lines 10-55). The film is blown into a bubble (column 3, lines 15-20).

Gasse et al. teaches that the film laminate based on polyamide and polyolefins, has good heat sealability and good surface slip (column 1, lines 55-65), and that the two polyamide layers are required to give elevated mechanical strength, specifically puncture resistance (column 5, lines 45-55).

Because Gasse et al. teaches that the bubble film laminate based on polyamide and polyolefins has good heat sealability, and that the two polyamide layers provide elevated puncture resistance, it would have been obvious to one of ordinary skill in the art to have used the five layer film bubble based on polyamide and polyolefins as taught by Gasse et al. in lieu of the polyolefin film in the invention of Last in order to obtain an air-tight balloon with the desired puncture resistance and heat sealability.

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (703)308-3265. The examiner can normally be reached Monday to Friday from 9:00 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (703)308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

8H

Sow-Fun Hon

05/23/03


HAROLD PYON
SUPERVISORY PATENT EXAMINER

1/1/2

5/28/03